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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,106	12/21/2001	Jean-Christophe Renauld	LUD 5752 DIV JEL/NDH (101	7513

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EXAMINER
HAMUD, FOZIA M

ART UNIT	PAPER NUMBER
1647	21

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

File copy

Office Action Summary	Application No.	Applicant(s)	
	10/026,106	RENAULD ET AL.	
	Examiner	Art Unit	
	Fozia M Hamud	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-37* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

1 Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, 24-25, 29, drawn to an isolated nucleic acid which encodes a cytokine receptor, an expression vector comprising said nucleic acid, a recombinant host cell and producing the encoded protein, classified in class 434, subclass 69.1.

II. Claims 13-18, 30-31, drawn to an isolated protein, class 530, subclass 350.

III. Claims 19-21, 26-27, 35-36, drawn to an antibody, classified in class 530, sub class 387.1.

IV. Claims 22-23, 32-34, 37, drawn to a method of using the protein of Group II to modulate the effect of AK155 or to identify binding partners for AK155, classified in class 435, sub class 7.2.

V. Claim 28, drawn to a method of determining expression of a nucleic acid which encodes an antagonist for AK155 binding protein by contacting the sample with a oligonucleotide which hybridizes to specific sequence, classified in class 436, sub class 501.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent use, that is distinct for each invention which cannot be exchanged. The nucleic acid of Group I can be used to make a hybridization probe or

can be used in gene therapy as well as in the production of the polypeptide of Group II. Although the antibody of Group IV can be used to obtain the nucleic acid of Group I, it can also be used in diagnostics (e.g. as a probe in immunoassays, or in immunochromatography) or it may be used therapeutically.

Since the invention of Group I includes a method of using the nucleic acid to produce the polypeptide of group II, inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the polypeptide of Group II can be prepared by materially different processes, such as by chemical synthesis, or can be obtained from nature using various isolation and purification protocols.

Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acid as claimed can be used therapeutically or can be used in a method of producing the encoded polypeptide.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the polypeptide of group II as claimed can be used therapeutically or can be used to raise antibodies.

Inventions I and IV, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the nucleic acid of group I is neither used nor produced in the methods of group IV.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the polypeptide of group II is neither used nor produced in the method of group V.

Inventions III and IV-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the antibody of group III is neither used nor produced in any of the methods of groups IV-V.

Inventions IV-V are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different

purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Additional Restriction Requirement

2. The claims the instant Application recite a multitude of nucleic acid and polypeptide sequences (SEQ ID Nos: 7, 9, 8 and 10). This constitutes a recitation of an implied, mis-joined Markush group that contain multiple, independent and distinct inventions. Each of the nucleic acids and polypeptides is independent and distinct because no common structural or functional properties are shared. Accordingly, these claims are subject to restriction under 35 U.S.C. 121.

Upon election of one of Group, Applicants are additionally required to elect a single nucleic acid or polypeptide sequence. This requirement is not to be considered as a requirement of an election of species, since each of the compounds recited in alternative from is not a member of a single genus of invention, but constitutes an independent and patentably invention.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has prima facie shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

3. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia M Hamud whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday, Wednesday-Thursday, 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (703) 308-4623. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4227 for regular communications and (703) 308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Fozia Hamud
Patent Examiner
Art Unit 1647
July 10, 2003

Yvonne Eyler

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